



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/694,845

10/29/2003

Stefan Jaroeh

SCH-1707

2491

23599

7590

09/29/2005

MILLEN, WHITE, ZELANO & BRANIGAN, P.C.
2200 CLARENDON BLVD.
SUITE 1400
ARLINGTON, VA 22201

EXAMINER

SEAMAN, D MARGARET M

ART UNIT

PAPER NUMBER

1625

DATE MAILED: 09/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/694,845

Applicant(s)

JAROCH ET AL.

Examiner

D. Margaret Seaman

Art Unit

1625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
 - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
 - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-21 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 12-21 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

This application is a Con of 09/787848 (filed 3/23/2001, ABN) which is a 371 of PCT/EP99/07091 (9/20/1999) which claims foreign priority to DE 19845830.4 (9/24/1998). Claims 1-11 have been canceled by preliminary amendment dated 10/29/2003. Claims 12-21 are before the Examiner.

Claim Rejections - 35 USC § 102

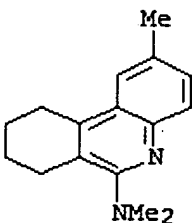
1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 12-14, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Bose (CA 76:85668) and Hollingsworth (CA 54:62618).. Bose teaches

RN 35417-80-2 CA
CN 6-Phenanthridinamine, 7,8,9,10-tetrahydro-N,N,2-trimethyl-
INDEX NAME)

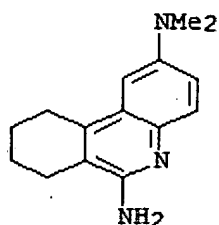


Art Unit: 1625

And Hollingsworth teaches

RN 100949-91-5 CA

CN Phenanthridine, 6-amino-2-dimethylamino-7,8,9,10-tetrahydro-
INDEX NAME)

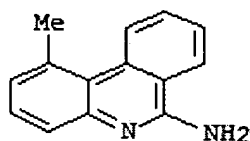


Both of these compounds anticipate the instant claims.

3. Claims 12, 14, 17, 19 and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Keene (CA 63:24038) and Baberkina (CA 113:78196). Keene teaches

RN 1859-17-2 CA

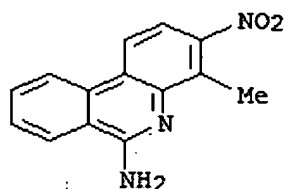
CN Phenanthridine, 6-amino-1-methyl- (7CI, 8CI)



Art Unit: 1625

RN 128422-33-3 CA

CN 6-Phenanthridinamine, 4-methyl-3-nitro- (9CI)

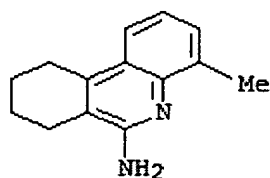


And Baberkina teaches

Which anticipate the instant claims.

4. Claims 12, 14-17 and 19-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Hollingsworth (CA 43:8385), IN 153442, and DE 3305329. Hollingsworth

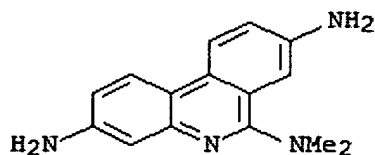
RN 855623-05-1 CA

CN Phenanthridine, 6-amino-7,8,9,10-tetrahydro-4-methyl- (5CI)
NAME)

teaches

RN 93494-47-4 CA

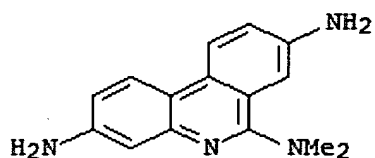
CN 3,6,8-Phenanthridinetriamine, N6,N6-dimethyl- (9CI)



IN teaches

Art Unit: 1625

RN 93494-47-4 CA
CN 3,6,8-Phenanthridinetriamine, N6,N6-dimethyl- (9CI)



DE teaches

Which anticipate the instant claims.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claim 12 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 12 is ambiguous due to the definition of R4, R4 and R5, and R5 and R6. The way these definitions are arranged, it is unclear as to the true meaning of these variables. It is suggested that the definitions be arranged somewhat as follows: "R4 is ___, R5 and R6 are ___, or optionally, R4 and R5 can optionally together with the 2 adjacent carbon atoms...".

7. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

1. Claims 16, 18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 16 lacks written description due to the other active ingredients. There is no description in the specification as to the identity or type of other active ingredients.

Claims 18 and 21 lack written description because the instant specification does not adequately describe the nexus between the modulation of the neuronal NDS or amyotrophic lateral sclerosis and a useful treatment of a disease/condition.

Modulation of a neuronal NDS involves antagonism, inhibition, agonism and others. These modulations are sometimes opposite reactions to the same receptor. It is not seen where the instant specification adequately describes the nexus between the modulation of the neuronal NDS and a useful treatment of amyotrophic lateral sclerosis or of a single disease or condition.

2. Claims 18 and 21 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

There are many factors to be considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue". These factors include 1) the breadth of the claims, 2) the nature of the invention, 3) the state of the prior art, 4) the level of one of ordinary skill, 5) the level of predictability in the art, 6) the amount of direction provided by the inventor, 7) the existence of working examples, and 8) the quantity of experimentation needed to make or use the invention based on the content of the disclosure. In re Wands, 858 F.2d 731, 737, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988).

- 1) The breadth of the claims,
- 2) The nature of the invention,
- 3) The state of the prior art,
- 4) The level of one of ordinary skill,
- 5) The level of predictability in the art,
- 6) The amount of direction provided by the inventor,
- 7) The existence of working examples,
- 8) The quantity of experimentation needed to make or use the invention based on the content of the disclosure.

The nature of the invention: The nature of the invention is the method of treating a disorder that is connected to neuronal NDS or amyotrophic lateral sclerosis.

Art Unit: 1625

The state of the prior art: The state of the prior art is that it involves screening in vitro and in vivo to determine which compounds exhibit the desired pharmacological activities (i.e. what compounds can treat which specific disease). There is no absolute predictability even in view of the seemingly high level of skill in the art. The existence of these obstacles establishes that the contemporary knowledge in the art would prevent one of ordinary skill in the art from accepting any therapeutic regimen on its face.

The predictability in the art: It is noted that the pharmaceutical art is unpredictable, requiring each embodiment to be individually assessed for physiological activity. In re Fisher, 427 F. 2d 833, 166 USPQ 18 (CCPA 1970) indicates that the more unpredictable an area is, the more specific enablement is necessary in order to satisfy the statute. In the instant case, the instantly claimed invention is highly unpredictable since one skilled in the art would recognize that in regards to the therapeutic effects of all diseases, whether or not the modulation of neuronal NDS would make a difference in amyotrophic lateral sclerosis or any other disease. Hence, in the absence of a showing of a nexus between any and all known diseases and the modulation of neuronal NDS, one of ordinary skill in the art is unable to fully predict possible results from the administration of the compound of claim 1 due to the unpredictability of the role of modulation of neuronal NDS.

The presence or absence of working examples: The instant specification has no working examples.

The amount of direction or guidance present: The guidance present in the specification is that of the compounds work to treat any and all diseases related to neuronal NDS and specifically amyotrophic lateral sclerosis. The specification does not seem to enable a correlation between the mediation of neuronal NDS and the treatment of any and all diseases.

The breadth of the claims: The claims are drawn to the treatment of any and all diseases mediated by Neuronal NDS with the compound of formula (I).

The quantity of experimentation needed: The quantity of experimentation needed is undue. One skilled in the art would need to determine what diseases out of all known diseases would be benefited by the mediation of neuronal NDS and then would further need to determine which of the claimed compounds would provide treatment of the disease.

The level of the skill in the art: The level of skill in the art is high. However, due to the unpredictability in the pharmaceutical art, it is noted that each embodiment of the invention is required to be individually assessed for physiological activity by in vitro and in vivo screening to determine which compounds exhibit the desired pharmacological activity and which diseases would benefit from this activity.

Thus, the specification fails to provide sufficient support of the broad use of the compounds of claim 1 for the treatment of any disease. As a result necessitating one of

ordinary skill to perform an exhaustive search for which diseases can be treated by which compound of claim 1 in order to practice the claimed invention.

Genentech Inc. v. Novo Nordisk A/S (CA FC) 42 USPQ2d 1001, states that "a patent is not a hunting license. It is not a reward for search, but compensation for its successful conclusion" and "[p]atent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable".

Therefore, in view of the Wands factors and In re Fisher (CCPA 1970) discussed above, to practice the claimed invention herein, one of ordinary skill in the art would have to engage in undue experimentation to test which diseases can be treated by the compounds of the instant claims, with no assurance of success.


This rejection can be overcome by deleting the claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D. Margaret Seaman whose telephone number is 571-272-0694. The examiner can normally be reached on 630am-4pm, First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecelia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


D. Margaret Seaman
Primary Examiner
Art Unit 1625

dms